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(N.E.) TH 1-28-03

MTIPAT.076A (formerly MPATENT.053A) PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Dean A. Klein	Group Art Unit 2131
Appl. No.	:	09/277,335	CERTIFICATE OF FAX TRANSMISSION
Filed	:	March 26, 1999	I hereby certify that this correspondence and all marked attachments are being transmitted via facsimile to Examiner Chi-Chung Lee, Fax No. (703) 746-7238 of the USPTO on the date shown below:
For	:	DATA SECURITY FOR DIGITAL DATA STORAGE	January 24, 2003 (Date)
Examiner	:	Chi-Chung Lee	Eric M. Nelson, Reg. No. 43,829

Do not enter

RESPONSE AFTER FINAL

United States Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

Dear Sir:

In response to the Office Action dated November 4, 2002, Applicant has the following comments.

Discussion of Rejection of Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 1-4, and 7-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,864,616 to Pond, et al in view of Computer Dictionary. Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pond in View of Computer Dictionary and further in view of Nishino.

One embodiment of applicant' invention is directed to a system for providing security on a computer disk drive. In this embodiment, a computer includes a identification code that is associated with the computer. The identification code is stored in a *non-erasable memory*, such as ROM or PROM. Preferably, each identification code is substantially unique to that computer.

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The code may be stored in the computer prior to purchase by the user. In one embodiment, the computer automatically and transparently to the user encrypts data that is sent to a data storage medium using the identification code.

In particular. Claim 1 recites: "retrieving an identification code from a *non-erasable* memory location in said personal computer." Independent Claim 5 recites: "storing a hardware identifier in a *non-erasable* memory integrated circuit." Independent Claim 7 recites: "wherein said information is stored in a *non-erasable* memory in said computer system."

Pond is directed to a system of cryptographically labeling electronically stored data. However, in Pond, there is no motivation or suggestion to store a machine identifier in a non-erasable memory location. Pond merely describes that "[d]uring installing of a PC security system, a machine identifier ("MID"") may be assigned to the individual PC". *See* Pond, col. 3, lines 11-12. There is no teaching or suggestion in Pond that the machine identifier should be stored in a non-erasable memory. Applicant respectfully submits that storing the machine identifier in a non-erasable memory provides enhanced security. Since the machine identifier is non-erasable, it would be difficult for a user to modify their machine identifier so as to read the data of others.

In the Office Action, the Examiner stated that, in Pond, "[t]he MID key is generated by MID is a bit pattern which is used in the encryption process and which may be stored in a secure portion of the PC's memory (see column 5 lines 35-40). Thus it would have been clear to one of ordinary skill in the art that the MID plays important role in copy protection system of personal computer. . . . One well-known way of preventing changes to stored data would be using a ROM because it's a semiconductor based memory that contains instructions or data that can be read but not modified."

Applicant submits that the prior art must suggest the desirability of the claimed invention. *See* M.P.E.P. § 2143.01. The fact that references can be modified is not sufficient to establish prima facie obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness. *Id.* In this case, the Examiner has merely made conclusory findings regarding the motivation to modify the Pond system. Applicant respectfully submits that the Examiner has

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failed to provide a prima facie rejection and that independent Claims 1, 19, and 21 are in condition for allowance.

Furthermore, Appellant submits that it is improper to combine references where the references teach away from their combination.[1] The Court of Appeals for the Federal Circuit has stated that a reference teaches away if a "person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference."[2] Additionally, to support a rejection under 35 U.S.C. § 103(a), the Examiner may not "pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."[3] Appellant submits that the Examiner in this case has failed to give due consideration to the disclosure of Pond that teaches away from its combination with ROM devices for storage of the machine identifiers.

Pond teaches that the MID identifies the location of the personal computer. Furthermore, Pond teaches that the MID keys are generated and stored at the time the PC is configured as part of a PC network. *See* col. 7, lines 43-36. Given this fact, Applicant respectfully submits that one of ordinary skill in the art would not consider using of a ROM or a programmable ROM ("PROM") to store the MID. A ROM is constructed from hard-wired logic, encoded in the silicon itself, much the way that a processor is designed. It is designed to perform a specific function and cannot be changed. This is inflexible and so ROM is only used generally for a program that is static (not changing often) and it is usually mass-produced. During mass production of a ROM, it would be difficult if not impossible to know the destination location of the computer in which it is to reside. Furthermore, the PROM requires special hardware for programming. Applicant respectfully submits that given the above, it would be overly complicated to include such information in a ROM or PROM which requires special manufacture for programming it or the use of special machinery.

Since Claims 2-4, 6, 8 and 9-12 each depend on one of Claims 1, 5, and 7, Applicant respectfully submits that the Claims are allowable for at least the reasons previously discussed.

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[1] *See In re Grasselli*, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983).
[2] *In re Gurley*, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994).
[3] *In re Wesslau*, 147 U.S.P.Q. 391, 393 (CCPA 1965).

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Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 1/24/03

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